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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,126	11/30/2001	Yuichi Takegawa	381NP/50668	8206

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 Crowell & Moring
 Evenson Mckeown Edwards & Leneha
 Intellectual Property Law Group
 1001 Pennsylvania Avenue N W
 Washington, DC 20004-2595

EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,126

Applicant(s)

TAKEGAWA, YUICHI

Examiner

Cheyne D Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15, 17-20, and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 16 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/20/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traversal of Group I, claims 13-16 and 21, Species a, unspecified type of method or system for accepting commission production of DNA chips, filed April 19, 2004, is acknowledged.
2. The traversal is on the ground(s) that "the alleged groups of claims a neither independent, nor distinct from one another." Applicant's argument has been fully considered and found to be unpersuasive because the invention Groups I, II, or III are independent and distinct from each other. For example, claims 13-16 and 21 of Group I are independent and distinct from the claims of Group II, or III, because claims 13-16 and 21 are not dependent from any of the claims in Group II or III. Further, claims 13-16 and 21 of Group I require critical limitations which are not present in either of the claims of Group II or III, which causes Group I to be distinct from Group II or III.
3. Specific to Applicant's argument that all three Groups are classified in the same class and subclass, the Groups being classified in the same class and subclass does not change the fact said Groups are distinct from each other as discussed above.
4. Therefore, the completely distinct critical features of each Group support the undue search burden if they were examined together.
5. The requirement is still deemed proper and is therefore made FINAL.
6. Claims 14 and 15 have been withdrawn due to being directed to species other than the elected species of an unspecified type of method or system for accepting commission production of DNA chips.

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7. Claims 13, 16, and 21, an unspecified type of method or system for accepting commission production of DNA chips, are examined on the merits.

IDS

8. Documents AQ and AR have been lined through because document AQ is not in the English language, and document AR does not have a publication date.

SPECIFICATION

9. The abstract of the disclosure is objected to because said abstract has more than 150 words. Correction is required. Applicant is required to submit a new abstract on a separate sheet. See MPEP § 608.01(b).

CLAIM REJECTIONS - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 13, 16, and 21 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Anderson (US006456942B1).

12. It is noted that the term “commissioned” has been reasonably construed as “to place an order for.”

13. Anderson discloses a method and network infrastructure for custom (setting arrangement of probes) microarray synthesis (production). The user submits (commissioned) a list of target

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sequences of interest through a network server, the server designs a set of probes (specific base sequences), submit the list of probes to the synthesizer, the synthesizer builds the probes on the surface (individual areas) of an array, and the chip is shipped to the user (column 2, lines 53-67), as in instant claim 13, lines 1-8; claim 16, lines 1-7; and claim 21, lines 1-8.

14. Figures 2-6 provides screen shots of exemplary user interfaces for controlling and examining the status of DNA-synthesis equipment, chip-manipulation equipment (column 4, lines 40-45). Figure 4 displays a drawing of a chip represented in the graphical box labeled "chip state", the chamber number in which the DNA is being synthesized, the cycle number, the parameters (control conditions), and the sequence being built (column 5, lines 19-31), as in instant claim 13, lines 9-11; claim 16, lines 8-9, and claim 21, lines 9-10.

15. Figure 3 demonstrates various functions that an operator can select from a computer interface program such as setting parameters used in synthesis and scheduling DNA sequences to build, and starting the DNA synthesis (confirmation), as in instant claim 13, lines 12-15; claim 16, lines 10-13; claim 21, lines 11-13.

CONCLUSION

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

17. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of

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document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

18. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

C. Dune Ly
6/20/04

Ardin H. Marschel 6/23/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER